

**REMARK**

Claims 1-55 are pending in the application. Claims 3, 18, 24-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 1, 2, 4-9, 11-14, 16, 17, 19-23 and 55 are rejected. Claims 10 and 15 are objected to.

Claims 1, 2, 6, 7, 8, 10, 15, 16, and 17 have been amended, claims 3, 18, and 24-55 have been canceled, and claims 56-73 have been added. While Applicants believe that the originally presented claims are patentable over all of the art cited in the Office Action as well as all other references submitted by Applicants, the claims have nonetheless been amended as follows in order to expedite the application toward allowance. The amendments are therefore made without prejudice or disclaimer, and Applicants reserve the right to pursue the original scope of the claims as provided prior to the cancellation or amendments, such as through continuation practice. Support for the amendments to claims 1, 2, 6, 7, 8, 10, 15, 16, and 17 and new claims 56-73 can be found throughout the specification and in the claims as filed. The amendments to claims 2, 6, 7, 8, 16, and 17 merely clarify the invention. Claims 10 and 15 have been rewritten in independent form. Support for the amendment to clarify claim 1 and for the phrase "total internal reflection" can be found on page 3, lines 15-18. Further support for the phrase "skin-contacting surface provides total internal reflection for at least a portion of the radiation when not in contact with the patient's skin, but passes said portion of the radiation to the patient's skin when in contact therewith" in claim 1 and support for the new claims 56, 61, 62, 68, and 69 can be found on page 31, lines 16-20. Support for new claims 57, 64 and 71 can be found on page 3, lines 21-23 of the specification. Support for new claims 58-60, 63, 65-67, 70 and 72 can be found on page 17, lines 8-9. and page 22, lines 1-20, page 9, lines 13-19. Support for new claim 73 can be found in Figure 1. Accordingly, no new matter has been added.

Applicants respectfully traverse the Examiner's rejections and request reconsideration of the application in view of the amendments made above and the remarks that follow.

***Allowable Subject Matter***

The Examiner has kindly indicated that claims 10 and 15 contain allowable subject matter. Accordingly, claims 10 and 15 have been rewritten in independent format to include the features of the base claims and intervening claims on which they depend. Hence, these claims are in condition for allowance.

***Claim Objection***

Claim 21 has been objected to because the skin-contacting surface is cited as a plate which conflicts with the independent claim of a protuberance. While the Applicants disagree that these elements are in conflict, the Applicants have nonetheless amended independent claim 1 to further clarify the claimed invention. Specifically, claim 1 now recites "an applicator having at least one protuberance comprising a skin-contacting surface." The Examiner is respectfully requested to withdraw this objection.

***Rejections under 35 U.S.C. § 112***

Claim 55 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. In response, Applicants have canceled claim 55 thereby rendering this rejection moot.

***Rejections under 35 U.S.C. § 102 and 103***

The claimed invention is directed to an apparatus for treatment of skin comprising an applicator having at least one protuberance and at least one optical radiation source. Independent claim 1, and claims dependent thereto, have been amended to include the safety feature of original claim 10, which has been deemed allowable by the Examiner. Specifically, amended independent claim 1 recites "a total internal reflection mechanism to prevent at least a portion of the radiation from passing through said skin-contacting surface unless in contact with skin."

Claims 1 is the only pending rejected independent claim. Claim 1 and dependent claims 2, 4-9, 11-14, and 16-23 stand rejected as being anticipated under 35 U.S.C. § 102(b) or 102(e), or as being obvious under 35 U.S.C. § 103(a). Specifically, claims 1, 2, 4-7, 13, 19 and 20 stand rejected as being anticipated by Lerner et al. (U.S. Patent No. 5,300,097); claims 1, 8, 9, 11, 14, and 21 are rejected as being anticipated by Bertwell et al. (U.S. Patent 5,358,503); claims 1 and 12 are rejected as being anticipated by Diamantopoulos et al. (U.S. Patent 4,930,504); and claims 1, 22, and 23 are rejected under as being anticipated by Knowlton (U.S. Patent 6,350,276). Claim 16 stands rejected as being obvious over Lerner et al. (U.S. Patent 5,300,097) in view of Yamazaki et al. (U.S. Patent No. 6,572,637) and claim 17 stands rejected as being obvious over Lerner et al. (5,300,097) in view of Chen et al. (5,445,608). Applicants respectively traverse these rejections in light of the amendments to independent claim 1. Based on the claim amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejections.

Independent claim 1 has been amended to recite allowable subject matter from original claim 10. Accordingly, independent claim 1 and dependent claims 2, 4-9, 11-14, and 16-23, which depend on claim 1, distinguish patentably over the cited art. None of the references, alone or in combination, teach or suggest the claimed invention. Accordingly, the Examiner is respectfully requested to withdraw the rejections and pass this case to allowance.

#### ***New Claims***

Claims 56-73 are presented to secure patent protection for other aspects of the invention consistent with the restriction requirement and the allowable subject matter identified in the Office Action.

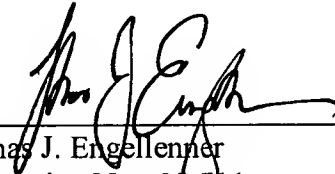
### CONCLUSION

In summary, the above-identified patent application has been amended and reconsideration is respectfully requested for all the reasons set forth above. In the event that the amendments and remarks are not deemed to overcome the grounds for rejection, the Examiner is kindly requested to telephone the undersigned representative to discuss any remaining issues.

Respectfully submitted,

NUTTER McCLENNEN & FISH LLP

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Thomas J. Engellenner  
Registration No.: 28,711  
Attorney for Applicants  
World Trade Center West  
155 Seaport Boulevard  
Boston, MA 02210-2604  
Tel: (617) 439-2948  
Fax: (617) 310-9948